



Docket No.: 701039-050920

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Zon et al.
SERIAL NO.: 09/758,007
FILED: January 10, 2001
FOR: METHOD FOR IDENTIFYING GENES INVOLVED IN CELL PROLIFERATION

EXAMINER: Martin L.
GROUP: 1633

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RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed on September 26, 2002, in which a Restriction Requirement was imposed by the U.S. Patent and Trademark Office ("PTO") Applicant hereby elects subject matter of Group VI (i.e., claims 18, 19 and 21-29) with traverse upon the following grounds.

First, restriction between Groups I, II, III, IV, V, and VI, especially V and VI, is improper. It is the burden of the PTO to demonstrate that restriction among the claimed subject matter is appropriate. In the present case, the PTO has simply asserted that the inventions of the groups are distinct because, "it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effect." The PTO's position, however, is lacking any evidence to support its conclusion.

There is no basis in the present application for concluding that the invention of Group I is incapable of being used together with the invention of Group II. Invention of Group I relates to a method of identifying a gene involved in cell proliferation. According to the PTO, Group II differs from Group I because the "screening is conducted by positional cloning." Applicants note that the screening is not conducted by positional cloning, but that positional cloning is a further step to isolate the gene. Moreover, as is set forth in the application, in order to use positional cloning one needs the F3 diploid embryo, which has been classified as a separate invention in Groups III and IV.

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Likewise, there is no basis in the present application for concluding that the invention of Group V is incapable of being used together with the invention of Group VI. The invention of Group V relates to a method of identifying a gene involved in carcinogenesis. Again, the PTO distinguishes the invention of Group V and VI by taking the position that the identification of the gene is conducted by positional cloning. As noted above, positional cloning is a further step used not to identify the gene, but to isolate the gene. Thus, the methods of Groups V and VI do not involve different method steps or different subject for screening. The basis for the PTO's conclusion, therefore, is not only unsupported, but also unfounded.

As noted in MPEP § 808.02 to support restriction between related inventions, "The Examiner . . . must show by appropriate explanation one of the following: a) separate classification thereof . . . ; b) separate status in the art when they are classified together . . . ; or c) a different field of search . . ." [emphasis added].

In this regard, Applicants respectfully submit that the PTO has failed to fulfill its obligation in demonstrating that these related inventions must be restricted. Specifically, the PTO has failed to demonstrate that the inventions cannot be searched together without undue burden because as noted by the PTO at pages 2 – 3 of the outstanding Office Action, the search for all the groups involved searching class 435 and either subclass 4, 6 and 7.1 or subclass 6 alone. Therefore, the search for the inventions of all the groups would nearly, if not completely, be coextensive. Applicants especially note that a search of elected Group VI, classified in class 435, and subclass 4, 6, 7 and 7.1 would be coextensive with a search of Group V, classified in class 435, subclass 6. Therefore, the search for the invention of Group VI and of Group V would be nearly, if not completely, coextensive. Where the classification is the same and the field of search is the same, as is the case here, there is no clear indication of separate future classification, as is the case here, no reason exists for dividing among the related inventions. (See, MPEP § 808.02.) Thus, the PTO has failed to carry its burden establishing that these related inventions require restriction.

In view of all of the forgoing, applicants respectfully submit that the restriction requirement should be withdrawn, or at a minimum, elected Group VI be combined with Group V.